

### REMARKS

By this Amendment, Applicants add new claims 21-23 to claim subject matter to which Applicants are entitled. No new matter is added. Claims 1-23 are now pending in this application.

In the Office Action mailed April 23, 2004, the Examiner rejected claims 1-8 and 10-20 under 35 U.S.C. § 102(e) as anticipated by Tamano et al. (U.S. Patent No. 6,032,157) and rejected claim 9 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme et al. (U.S. Patent No. 5,848,373). Applicants note that on page 2 of the Office Action the Examiner indicated that claims 1-20 were rejected under 35 U.S.C. § 102(e) as anticipated by Tamano, however, claim 9 was not discussed under this rejection. It thus appears that claim 9 was inadvertently listed on page 2. Applicants respectfully traverse the rejection for at least the following reasons.

Regarding the rejection of claims 1-8 and 10-20 under 35 U.S.C. § 102(e) as anticipated by Tamano, Applicants respectfully submit that the Examiner has not demonstrated a *prima facie* case of anticipation. In order to properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8<sup>th</sup> ed., Aug. 2001), *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8<sup>th</sup> ed. 2001), p. 2100-69.

Claim 1 recites a combination of elements including, among other things, “selecting a boundary of a geographic region in a first map” and “upon selecting the boundary, simultaneously configuring the boundary in the first map for display in a first area of a display and configuring the corresponding boundary in the second map for display in a second area of the display.” Tamano fails to teach a combination including at least these features of Applicants’ claimed invention. Since Tamano does not teach each and every element of claim 1, it cannot anticipate claim 1.

By contrast, Tamano discloses that image information linked with attribute information is referred to as first image information, and information that approximately corresponds to the first image information is referred to as second image information and is not linked to the attribute information. An object contained in the second image information is used as a key, and the attribute information linked with the first image information is retrieved by inputting a correspondence between the second image information and the first image information via the key, i.e., by selecting an object in the second image information. See Tamano, col. 2, lines 41-52. In other words, in Tamano, an object is selected in the second image information. The selected object is linked to the same object appearing in the first image information. The system then retrieves attribute information that is linked to the object in the first image information. See id.

Tamano in col. 8, lines 34-54, which was also relied upon by the Examiner in rejecting claim 1, further discloses that first information and second information can be linked to each other. Furthermore, Figs. 10(a)-(e) and 11(a)-(e) merely illustrate this concept. However, these teachings of Tamano do not constitute “selecting a boundary

of a geographic region in a first map” and “upon selecting the boundary, simultaneously configuring the boundary in the first map for display in a first area of a display and configuring the corresponding boundary in the second map for display in a second area of the display,” as recited in claim 1. Instead, Tamano is silent on configuring boundaries of maps. In particular, as shown in Figs. 10(a)-(e) and 11(a)-(e), the boundaries of each map are not configured. Instead, each map displays the same region before and after it is linked. For at least these reasons, the Examiner has not shown that Tamano anticipates all of the features of claim 1 and should thus withdraw the rejection of claim 1.

Claims 2-17 depend directly or indirectly from claim 1. For at least the same reasons discussed above in relation to allowable claim 1, Applicants respectfully request the Examiner to withdraw the rejection of claims 1-17 under 35 U.S.C. § 102(e).

Independent claims 18 and 20, although of a different scope from each other and claim 1, include some recitations of a scope similar to that of claim 1. For example, claims 18 and 20 recite combinations of elements including, among other things, “selecting a boundary in a geographic region of a first map” and “upon selecting the boundary, simultaneously displaying the boundary from the first map in a first area of a display and displaying the corresponding boundary from the second map in a second area of the display.” Claim 19 depends from claim 18. For at least the same reasons discussed above in relation to allowable claim 1, Applicants respectfully request the Examiner to withdraw the rejection of claims 18-20.

Regarding the rejection of claim 9 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme, Applicants respectfully submit that the Examiner has not

demonstrated a *prima facie* case of obviousness. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must meet each of the following three requirements. First, the reference taken alone, or references combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, and not be based on applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

As discussed above, Tamano does not disclose or suggest all of the elements of claim 1. Claim 9 depends directly from claim 1. DeLorme discloses a computer aided map location system that provides correlation and coordination of spatially related data between a computer and a set of printed maps. However, DeLorme does not make up for the deficiencies of Tamano discussed above. At least due to its dependency from allowable claim 1, the Examiner should withdraw the rejection of claim 9.

Additionally, Applicants respectfully disagree with the Examiner's alleged motivation to combine Tamano and DeLorme. For example, the Examiner alleges it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of DeLorme into Tamano "to modify . . . Fig. 2 of Tamano by incorporating a second database of DeLorme that displays selected loc/objects of the second database on the grid quadrangles of the second scale grid

presented on the CAMLS PDA/PC/EC display for coordinating and correlating locations on the computer display with locations on corresponding printed maps" (Office Action, page 7).

However, because Tamano discloses retrieving attribute information that is linked to an object in a first image based upon a user's selection of an object in a second image, Tamano does not contemplate incorporating an additional database, as the Examiner suggested. Incorporating an additional database would not prove effective because the system of Tamano requires the use of link information table 30, which stores a correspondence between objects of a first image and a second image. There is thus no suggestion or motivation to combine the references in a manner that would result in the claimed invention. Nor has the Examiner shown that there would be a reasonable expectation of success for incorporating an additional database with longitude and latitude coordinates as disclosed by DeLorme with the teachings of Tamano. Instead, an additional database would be inconsistent with Tamano's use of link information table 30. Accordingly, the rejection of claim 9 is improper for at least these additional reasons.

Finally, new claims 21-23 are directed to embodiments of Applicants' invention and are neither disclosed nor suggested by the cited prior art. Accordingly, the Examiner should allow new claims 21-23.

#### **CONCLUSION**

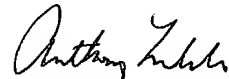
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 23, 2004

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